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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Menachem Levanoni

Serial No.: 09/809,577

Group Art Unit: 2121

Filed: March 15, 2001

Examiner: T. Pham

For: DYNAMIC TECHNIQUES FOR CUSTOM-FIT KNEE REPLACEMENTS

Honorable Commissioner of Patents  
Alexandria, Virginia 22313-1450**PETITION TO WITHDRAW FINALITY OF REJECTION AS PREMATURE  
UNDER 37 C.F.R. §1.181**

Sir:

Applicant respectfully petitions under 37 C.F.R. §1.181 that the finality of Patent Application S/N 09/809,577: "DYNAMIC TECHNIQUES FOR CUSTOM-FIT KNEE REPLACEMENTS" be withdrawn as premature under the guidelines of MPEP §706.07(a). This guideline states: "... second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims ...." (Emphasis by Applicant).

Applicant respectfully submits that, contrary to the Examiner's position in the latest Office Action dated December 31, 2003, one of ordinary skill in the art would readily recognize that the claim amendments in the Amendment Under 37 C.F.R. §1.111, filed on October 9, 2003, were not at all directed to the purpose of overcoming the rejection of the Office Action dated July 9, 2003, based on US Patent 6,540,707 to Stark et al., further in view of US Patent Publication 2002/0072828 to Turner et al., and US Patent 5,799,296 to Wang. Applicant submits that no

claim amendments were necessary to overcome this rejection and that the amendments were clearly not so intended.

Indeed, based upon the prior art presented in the July 9, 2003, Office Action, Applicant broadened the scope of the independent claims in the Amendment filed October 9, 2003.

As Applicant pointed out in the Amendment Under 37 C.F.R. §1.111, filed on October 9, 2003, the rejection in the Office Action of July 9, 2003, simply failed to meet the initial burden of a *prima facie* rejection under 35 U.S.C. §103(a). As pointed out in the Amendment Under 37 C.F.R. §1.116, concurrently filed herewith, Applicant additionally submits that the new rejection presented in the Office Action dated December 31, 2003, likewise fails to meet the initial burden of a *prima facie* rejection under 35 U.S.C. §103(a).

For at least the reasons outlines above, Applicant petitions that the finality of rejection for the above-identified Application be withdrawn.

Respectfully submitted,

Date: 3/1/04



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